

REMARKS

The Office has issued a restriction requirement between the following groups of claims:

- (I) claims 1-14 (drawn to a floor coating composition), and
- (II) claims 15-17 (drawn to a material coated with the floor coating composition).

In response to the restriction requirement, applicants elect, with traverse, the invention of Group I (i.e., claims 1-14) for further prosecution.

Groups I and II allegedly are unrelated because the claims are drawn to an intermediate and a final product. According to the Office, distinctiveness can be shown for claims with this type of relationship if the intermediate can be used in a product other than the claimed final product. Applicants respectfully submit that the restriction requirement is improper for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending

claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully submit that the restriction requirement as between the claims of Groups I and II is improper because the nature of the claims is such that any burden encountered in searching the groups together would, at most, be slight (and certainly not "serious"). In this respect, the claims of Group I (claims 1-14) are directed to a floor coating composition. The claims of Group II (claims 15-17) are directed to a coating composition-coated material comprising the floor coating composition of claim 1 (i.e., Group I). If the composition claims of elected Group I are determined to be patentable, the use thereof must be novel and unobvious (i.e., the claims of Group II). As such, any search and consideration of the claimed subject matter of Group I will necessarily overlap the search and consideration of the claimed subject matter of Group II.

Accordingly, there would appear to be sufficient similarity between the claims of Groups I and II to allow for the search and examination of the subject matter of claims 1-17 at the same time without a "serious burden" being placed on the Examiner. Applicants, therefore, respectfully request withdrawal of the Restriction Requirement, and respectfully submit that the claims of Groups I and II should be examined together. If, however, the Restriction Requirement cannot be withdrawn, applicants respectfully request that the claims of Group II (i.e., claims 15-17) be rejoined for examination in the event that the claims of elected Group I are found allowable. Such rejoinder would be appropriate since, as discussed above, the claims of Group II are drawn to a coated material comprising the composition of claim 1 of elected Group I.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


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